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IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 773

TUBULAR SERVICE AND ENGINEERING COMPANY, TUBOSCOPE COMPANY, MYRON M. KINLEY, AND JOHN CARY KINLEY, *Petitioners*

v.

SUN OIL COMPANY, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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v.

SUN OIL COMPANY, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

The Petitioners above named pray that a writ of certiorari issue to review the decision in this cause of the United States Court of Appeals for the Fifth Circuit.

OPINION BELOW

A copy of the opinion (R. 1117) upon which review is sought is in Appendix No. 1 attached to this petition. The opinion is reported at 220 F. 2d 27.

JURISDICTION

The ground on which the jurisdiction of this Court is invoked is that the United States Court of Appeals for the Fifth Circuit, by its decision herein, has decided important questions of Federal patent law in a way which conflicts with applicable decisions of this Court.

The opinion (R. 1117) sought to be reviewed was rendered March 11, 1955, and the Judgment (R. 1130) was entered March 11, 1955. A petition for rehearing (R. 1131) was filed March 25, 1955. It was denied (with no opinion) on April 5, 1955. (R. 1140)

The statute conferring jurisdiction on this Court is 28 U. S. Code, Sec. 1254.

QUESTIONS PRESENTED FOR REVIEW

1. Where, during the prosecution of an application for patent, some definitive clauses are deleted from the claims to broaden them, and other definitive clauses are inserted in the claims to avoid the prior art, is it proper for a court to apply the doctrine of equivalents to such clauses and construe them as being directed merely to matters of design, or are such definitive clauses to be regarded as imposing limitations and restrictions on the patent which preclude such application of the doctrine of equivalents under the rules of law of *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47, and *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211?

2. In *Muncie Gear Works* v. *Outboard Marine & Mfg. Co.*, 315 U.S. 759, it was held that where an applicant for patent on a combination of elements discloses the combination in a specification filed in the Patent Office in time, but delays claiming the particular combination for more than the statutory period (then two years) after an adverse public use, he is precluded, both in equity and by statute, from obtaining a valid monopoly on what was thus untimely asserted.

Does the doctrine of equivalents limit application of the rule of the *Muncie Gear Works* case, or should an applicant for a patent on a specific combination of elements, who presents his claims thereon too late, be denied the benefit of earlier rejected claims defining a different combination of elements?

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STATUTES INVOLVED

Statutes in Force Prior to 1952 Patent Codification Act

35 U. S. Code Sec. 31

Inventions Patentable

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. R.S. § 4886; March 3, 1897, c. 391, § 1, 29 Stat. 692; May 23, 1930, c. 312, § 1, 46 Stat. 376; Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212.

35 U. S. Code Sec. 33

Application for Patent; Description; Specification and Claim

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish

it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible. R.S. § 4888; March 3, 1915, c. 94, § 1, 38 Stat. 958; May 23, 1930, c. 312, § 2, 46 Stat. 376.

Applicable Sections of 1952 Patent Codification Act

35 U. S. Code Sec. 102

Conditions for Patentability: Novelty and Loss of Right to Patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

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(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. July 19, 1952, c. 950, § 1, 66 Stat. 797.

35 U. S. Code Sec. 112

Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. July 19, 1952, c. 950, § 1, 66 Stat. 798.

STATEMENT OF THE CASE

On August 15, 1950, the United States Patent Office granted the Sun Oil Company, Respondent, the patent in suit, No. 2,518,663, on an invention in Tube Calipering and Recording Means made by Preston E. Chaney and William E. Barnes.

Respondent seeks a monopoly on all mechanical calipers for use in measuring tubing in oil wells. Respondent has

granted a license under the patent only to one concern, Otis Pressure Control Inc. of Dallas, Texas. The license is exclusive and Respondent seeks to enjoin all competitors of its licensee.

There are no competitors other than Petitioners. Petitioners manufacture only in the 5th Circuit. Use of the calipers is confined almost entirely to oil wells in Texas and Louisiana. No concern could do business without coming into Texas or Louisiana and being subject to suit in the 5th Circuit.

During the prosecution of the application for the Chaney & Barnes patent, Respondent learned that Petitioners were commercially using tubing calipers. At the time when Respondent learned this, the claims in the application for the patent did not define what Petitioners were using, so Respondent cancelled those claims and put in new ones. These new claims were rejected by the Examiner on the prior art, so Respondent cancelled them and put in still another new set, which were more limited in scope. These were allowed, and when the patent issued, this suit was brought.

This Petition is based on the File Wrapper of the patent in suit. Excerpts from the File Wrapper will be found in Appendix No. 2 filed with this Petition. These excerpts are taken from the *certified* File Wrapper, which is Plaintiff's exhibit 2, and which is on file in this Court. For ready comparison, the page numbers of the excerpts in Appendix No. 2 are the same as those at the bottom of the pages, written in pencil, of the *certified* File Wrapper.

The history of the prosecution of the claims of the patent in suit is as follows:

As filed on October 26, 1945, the application contained claims 1 to 9 (Appendix No. 2, pages 15 to 20).

On August 31, 1946, claims 10 to 19 were added (Appendix No. 2, pages 24 to 33).

On March 7, 1947, claims 1 to 19 were rejected by the Examiner (Appendix No. 2, pages 35 to 40).

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On September 6, 1947, claims 1 to 19 were cancelled and new claims 20 to 26 were presented (Appendix No. 2, pages 41 to 46).

On February 11, 1949, claims 20 to 26 were cancelled and new claims 27 and 28 were presented (Appendix No. 2, pages 51 to 54).

On August 30, 1949, a full report was made to Respondent's attorney on Petitioners' accused calipers by one Warner M. Kelly, who had inspected Petitioners' calipers in August, 1948, March, 1949, and again in July, 1949 (R. 229, 230, Appendix No. 2, pages 100, 102, 104).

On September 23, 1949, the specification of the application was extensively revised, claims 27 and 28 were cancelled and new claims 29 to 33 were presented (Appendix No. 2, pages 62 to 69).

On October 13, 1949, claims 29 to 33 were rejected by the Examiner (Appendix No. 2, pages 77 to 83).

On March 11, 1950, claims 29 to 33 were cancelled and new claims 34 to 37 were presented (Appendix No. 2, pages 84 to 87).

New claims 34 to 37 were allowed and became the claims of the patent, and these are the ones in suit.

It is self-evident that the rejected claims are not the same as the allowed claims. The only purpose in repeatedly presenting new claims was to define a combination which had not been defined before.

Respondent's attorney testified that when he cancelled claims 27 and 28, which defined a particular chart recording mechanism not used by Petitioners, and presented the new claims 29 to 33, his purpose was to have claims "couched in more generic language," and that this change was made to cover Petitioners' devices (R. 194).

But claims 29 to 33 were rejected on the prior art, and so it was necessary to bring more elements into the claims. It was not until March 11, 1950, when claims 34 to 37 were presented that the Examiner allowed anything. These new claims 34 to 37, for the first time in the prosecution,

included a stylus spring. This spring is defined in these claims as "means for resiliently urging said common actuating means in one direction."

Claims 34 to 37 were also the first to define the relative strengths of the feeler springs and the stylus spring, and when these claims were presented the attorney for Respondent told the Examiner that the relative strengths of these springs was "an essential and wholly novel feature of the invention," and that it was this feature which brought about the "new result." (Appendix No. 2, pages 88, 89 and 90).

In view of this history in the Patent Office, the main defenses relied upon by Petitioners in the Courts below were the doctrine of late claiming and abandonment, pleaded in Paragraph XVI (R. 21) of the Answer, and the doctrine of file wrapper estoppel pleaded in Paragraph XV (R. 20, 21) of the Answer.

The District Court held adversely to Petitioners on these and every other issue in the case. Except for refusing to award treble damages, the District Court adopted, with no change, the 51 Findings of Fact and 15 Conclusions of Law proposed by Counsel for Respondent. These Findings and Conclusions appear in the Record at pages 1087 and 1104.

The District Court's Findings and Conclusions do not specifically mention the defense of late claiming and abandonment, but Findings Nos. 48 and 49 (R. 1101), in effect, hold that the rule of the *Muncie Gear Works* case does not apply because the changes in the claims during the prosecution are immaterial "under the doctrine of mechanical equivalents."

As to infringement, the District Court held, in effect, that some of Petitioners' calipers have the relative spring strengths defined in the claims, and that others of Petitioners' calipers do not, but that all infringe because the relative strengths of springs is a "matter of design." (Findings Nos. 37 and 38, R. 1098 and 1099).

In the Court of Appeals, the rule of the *Muncie Gear Works* case, as we have stated it above, was recognized,

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but the rule was held to be limited by a "reasonable application of the doctrine of equivalents." (R. 1124, 1125).

On the question of infringement, the Court of Appeals ignored the File Wrapper and applied the doctrine of equivalents to the definition of the relative spring strengths. The Court of Appeals stated (R. 1125) that neither the express language of the claims, nor the doctrine of equivalents may be so narrowly circumscribed as to impose limitations and restrictions on the patent such as are inherent in acceptance of Petitioners' weak feeler spring defense. The Court of Appeals stated (R. 1128, 1129) that the language of the claims on the relative strengths of the springs is "largely a variable factor of optional engineering design."

FEDERAL JURISDICTION OF COURTS BELOW

This is a suit for patent infringement. Jurisdiction of the Courts below is founded on 28 U. S. Code, Sections 1338 and 1400.

ARGUMENT

Reasons for Granting Writ

The questions here presented involve the doctrine of file wrapper estoppel and the doctrine of equivalents. These doctrines are involved in practically all patent litigation. Therefore, public interest compels strict compliance with the rules laid down by this Court on those doctrines.

These doctrines are of even greater public importance where the patentee is seeking a monopoly.

Where a monopoly is sought in an industry concentrated in one circuit, so that it is improbable that conflict between circuit courts will arise, that alone is a ground for this Court to grant certiorari. *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47; *Muncie Gear Works* v. *Outboard Marine & Mfg. Co.*, 315 U.S. 759.

As to the first question presented, the application of the doctrine of equivalents to the deletions in claims 27

and 28 and to the insertions in claims 34 to 37, after the adverse rights of the public had intervened, violates the rules repeatedly laid down by this Court. It is not permissible to apply the doctrine of equivalents to such definitive clauses, and such clauses cannot properly be regarded as defining merely a factor of optional engineering design.

> "... the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened."
>
> *Schriber-Schroth* v. *Cleveland Trust Co.*, 305 U.S. 47, 57, 83 L. Ed. 34, 39.

> "The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer."
>
> *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 221, 85 L. Ed. 132, 137.

> "By striking that phrase from the claim and substituting for it 'embedded in the table' the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also embedded in it. By the amendment he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference. Hubbell v. United States, 179 U.S. 77, 83, 45 L. ed. 95, 99, 21 S. Ct. 24; Weber Electric Co. v. E. H. Freeman Electric Co., 256 U.S. 668, 677, 678, 65 L. ed. 1162, 1167, 1168, 41 S. Ct. 600; I. T. S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429, 440, 444, 71 L. ed. 335, 341, 343, 47 S. Ct. 136; Smith v. Magic City Kennel Club, 282 U.S. 784, 789, 75 L. ed. 707, 712, 51 S. Ct. 291; Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 85 L. ed. 132, 61 S. Ct. 235, cf. in case of disclaimer Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 492, 493, 79 L. ed. 1005, 1015, 1016, 55 S. Ct. 455. The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him.

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Smith v. Magic City Kennel Club, supra (282 U.S. 790, 75 L. ed. 712, 51 S. Ct. 291); Shepard v. Carrigan, 116 U.S. 593, 598, 29 L. ed. 723, 724, 6 S. Ct. 493; Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 228, 26 L. ed. 149, 151. As the question is one of construction of the claim it is immaterial whether the examiner was right or wrong in rejecting the claim as filed. Hubbell v. United States, supra (179 U.S. 83, 45 L. ed. 99, 21 S. Ct. 24); I. T. S. Rubber Co. v. Essex Rubber Co., supra (272 U.S. 443, 71 L. ed. 342, 47 S. Ct. 136). It follows that what the patentee, by a strict construction of the claim, has disclaimed—conductors which are carried by the table but not embedded in it—cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed."

Exhibit Supply Co. v. *Ace Patents Corp.*, 315 U.S. 126, 136, 86 L. Ed. 736, 744 and 745.

As to the second question presented, both the old statutes and those of the new 1952 Patent Codification Act, quoted above, prevent the grant of a valid patent on an invention which has been "abandoned."

Delay in making timely claims has been regarded as abandonment ever since *Pennock & Sellers* v. *Dialogue*, 2 Peters 1, 7 L. Ed. 327.

Especially where a structure has been put into commercial use by others, an applicant for patent has not been permitted to broaden his claims, by amendment, to cover that structure. The adverse rights of the public have then "intervened." *Webster Electric Co.* v. *Splitdorf Electric Co.*, 264 U. S. 463, 68 L. Ed. 792. If more than the statutory time (one year in the present case) has lapsed, after the intervening public use, the delay is fatal and no excuse can be offered. This is the rule of the *Muncie Gear Works* case, *supra*.

The facts here are exactly the same as those in the *Muncie Gear Works* case. There, the patent was on an outboard motor for boats. The drawings of the applica-

tion for patent showed two features described in the specification as an anti-cavitation plate and an anti-torque plate. The claims included the anti-torque plate until the applicant saw that the competitors were selling outboard motors without an anti-torque plate. More than two years lapsed before the applicant cancelled the anti-torque plate from his claims and put the emphasis on the anti-cavitation plate. Claims 11 to 14 of the patent were held invalid because of this change in emphasis.

Heretofore, attempts to capture what has gone into public use have frequently been condemned. *Mahn* v. *Harwood,* 112 U. S. 354, 28 L. Ed. 665; *Dwight & Lloyd Sintering Co.* v. *Greenawalt,* 27 F. 2nd 823 (CA-2); *Chicago Pneumatic Tool Co.* v. *Hughes Tool Co.,* 192 F. 2nd 620, 627 (CA-10).

If the Court of Appeals is correct in stating (R. 1125) that the doctrine of equivalents has the effect of making allowed claims 34 to 37 (Appendix No. 2, pages 84 to 87) of the application for the patent here in suit define the same invention as rejected and cancelled claims 27 and 28 (Appendix No. 2, pages 51 to 54), then the rules of the *Webster Electric Co.* case and the *Muncie Gear Works* case as to intervening rights and late claiming are completely vitiated.

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CONCLUSION

The decisions of this Court have not been followed by the Courts below.

The questions presented are important to the public.

For the above reasons, this petition should be granted.

Respectfully submitted,

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Service of this Petition has been made upon Sun Oil Company, Respondent, by mailing a copy by air mail, with postage prepaid, to each of its attorneys, Mr. Theodore E. Simonton, 11 Lincklaen Street, Cazenovia, New York; Mr. Ralph Browning, 3303 Montrose Boulevard, Houston 6, Texas; and Mr. Frank Busser, 1608 Walnut Street, Philadelphia 3, Pennsylvania, this day of May, 1955.

Attorney for Petitioners

APPENDIX No. 1

In The

United States Court of Appeals

For The Fifth Circuit

No. 15177

Tubular Service and Engineering Company, Tuboscope Company, Myron M. Kinley and John Cary Kinley,

Appellants,

v.

Sun Oil Company,

Appellee.

Appeal from the United States District Court for the Southern District of Texas.

(March 11, 1955.)

Before Hutcheson, Chief Judge, Rives, Circuit Judge and Dawkins, District Judge.

Rives, Circuit Judge: This appeal is from the district court's holding that appellee's patent No. 2,518,663, described as a "Tube Calipering and Recording Mechanism," is valid and infringed by certain devices manufactured and used by appellants.

The patent in suit was granted August 15, 1950 to Preston E. Chaney and William E. Barnes, employees of appellee, on their application filed October 26, 1945. Specifically, the claimed invention therein relates to an improved type of mechanical measuring and recording instrument known as a tubing caliper. Such instrument is used in high pressure oil or gas wells to determine the extent of corrosion existent in the well tube, without the necessity and expense of removing the tube from the ground, and has considerable utility in revealing when a tube or section thereof should be removed and replaced in order to prevent extensive damage resulting from its fracture or breakage.

As the patent and physical exhibits show, the Chaney-Barnes patented structure reveals six small wheels or discs, called "feelers", which protrude under spring pressure from a housing so as to engage the inner surface of tubing into which the device is lowered. Deviations in the normally smooth inner surface of the tube caused by corrosion pits are translated through the "feelers" by means of a recording mechanism within the housing and reflected on a graph or chart which is removed and studied to evaluate the tube's condition.

The validity and infringement of Claims 1 through 4 of the Chaney-Barnes patent in suit are here in issue, Claim 1 being a typical embodiment of the inventive concept involved and reading as follows:

> "1. In an internal tube wall calipering and recording device adapted to be passaged through an extended length of tubing the combination comprising an elongated housing, recording means

including a recorder member and a single stylus member mounted in said housing, a plurality of independently movable feelers spaced circumferentially of said housing and *adapted for independent lateral movement between said housing and the tube wall being calipered,* mechanical actuating means for said recording means common to all of said feelers and mounted in said housing for reciprocal movement therein, means for resiliently urging said common actuating means in one direction, and a plurality of movement transmitting means, one for each of said feelers, operable independently of each other to transmit outward movement of said feelers to said common actuating means, each movement transmitting means including *means for constantly and independently urging the corresponding feeler outwardly of said housing and for simultaneously urging its movement transmitting means in opposition to, and with a force greater than, said first-mentioned urging means,* whereby said common actuating means is movable in response to any of said feelers but is moved to an extent corresponding to and controlled by only the greatest outward feeler movement at any instance during a calipering passage." (Emphasis ours.)[1]

The district court adopted findings of fact and conclusions of law proposed by appellee, in effect holding that the essentially novel inventive concept of the Chaney-Barnes patent, which established its validity and

[1] As will hereinafter be noted, the emphasized portions are important in considering the basic issues of validity and infringement of the patent in suit. The first italicized phrase of Claim 1 also appears verbatim in Claims 2, 3 and 4 of the patent. Those remaining claims also define substantially the same element described in the second italicized phrase, though in different words.

distinguished it from the prior art, lay in its "automatic selection, measurement and recording of the single, largest radius corresponding to the deepest pit encountered at each level of a well tubing being calipered"; that the element urged by defendants (appellants) as essential to the Chaney-Barnes invention, though not recited in the claims, was a spring and plug "centering device", but that the patent claims did not either expressly or impliedly include this element; that, even though desirable and advantageous in some respects, the centering device was neither a necessary nor essential element of the invention, since the patented device would operate effectively without it "to record the depths of the deepest pits encountered", the desired function of maintaining the device in a centered position during operation then being performed "by the feelers themselves"; that the admitted omission of the centering device in appellants' accused structures was, therefore, "immaterial to the issue of infringement", and since they otherwise revealed every essential element of the patent claims, functioning in combination in substantially the same way to effect substantially the same result, they constituted infringement thereof.[2] The court rejected appellants' special defenses of prior public use and intervening rights, as well as their reliance upon a prior suit between the parties or their alleged privies as controlling in their favor,[3] holding that the prior Kinley Caliper uses in

[2] The district court found that appellants' infringement was willful and deliberate in character, though it declined in its discretion to assess treble damages.

[3] The prior suit was brought in 1952 by the individual appellants, Myron and John Kinley, against appellee's licensee, Otis Pressure Control, Inc., in the United States District Court for the Northern District of Texas, Dallas Division (Civil Action No. 4510). In an apparently unreported decision, Judge Atwell held the McMahan prior art patent, which had been acquired by the Kinleys, valid and infringed by certain calipers then being manufactured by appellee's licensee, Otis Pressure Control, Inc.

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1948 were experimental in nature and "were not public uses" such as would create intervening rights in favor of appellants, or otherwise restrict or limit the scope of the claims; finally, it held that the former suit relied upon by appellants was "without effect upon the issues herein involved."[4]

Though disavowing any intimation that "the Chaney-Barnes invention is inoperative or wholly lacking in utility", and even conceding that it "advanced the art" and solved the problem of "determining the depth of the deepest pit encountered", appellants nevertheless insist that the patent is invalid because the precise invention now claimed was abandoned by appellee during prosecution of the Chaney-Barnes patent application;[5] that, assuming validity, the district court was unjustified in according the Chaney-Barnes patent near pioneer status in its broad interpretation of the claims, particularly in view of the McMahan, Hardel and Kinley prior art patents[6]

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[4] In so holding, the court adopted the theory that the former litigation was not binding here, because the caliper of its licensee there held to infringe had a latch and release mechanism akin to the McMahan patent which is nowhere revealed in the Chaney-Barnes patent in suit.

[5] See 35 U.S.C.A. 31; 35 U.S.C.A. 102 (Patent Codification Act of 1952). Appellants' defense here is allegedly based on the doctrines of late claiming and intervening rights set forth in Muncie Gear Co. v. Outboard Marine & Mfg. Co., 315 U.S. 759, and cases in accord. Relying principally upon that decision, and the alleged Kinley public use in 1948, appellants urge that appellee's delay in seeking its presently claimed monopoly for more than one year after such prior public and adverse commercial use invalidates the patent in suit. See Rosaire v. Baroid Sales Division, National Lead Co., slip opinion dated January 7, 1955, No. 15,035.

[6] Specifically, these are: McMahan patent No. 2,544,609; Hardel patent No. 1,337,955; and Kinley patent No. 2,102,080. Other prior art patents considered either by the Patent Office before issuance, or distinguished by the district court in its findings of validity and non-anticipation, are the Brandon electrical caliper No. 2,322,343; the tubing caliper patents to De Leeuw No. 1,416,694 and Stark No. 2,121,614, found by the district court to be "entirely remote, structurally and functionally," from the Chaney-Barnes caliper; the Kinley and Gupton patent No. 2,267,110, and

and uses; that the scope of appellee's monopoly under the Chaney-Barnes patent is necessarily limited by the specifications and language of the claims, as well as by the Patent Office file wrapper and the prior art[7] as a whole to a combination of known mechanical elements which include a "centering device" enabling the "feelers" to have that "independent lateral movement between said housing and the tube wall being calipered" described in the claims; that the district court clearly erred in holding that the "feelers" of appellants' structures, which use no centering device, have such "independent lateral movement" within the meaning of the patent claims, and particularly in finding that "the omission of the centering spring and plunger in defendant's calipers * is immaterial to the issue of infringement"; that the district court further erred in finding that the desired function of centering the device could be just as effectively performed "by the feelers themselves," since the phrase "independent lateral movement between said housing and the tube wall," both as a matter of law and physics, impliedly limits the patented structure described to the use of a centering device; that, if the claims were properly construed by the district court as not being impliedly limited to a caliper using a centering device, they dis-

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the Robidoux patent No. 2,340,987. Further prior art patents found ineffective to establish invalidity for anticipation because taken from the remote and non-analogous textile and shoe machinery arts are: Dennison No. 65,158, Vassar No. 212,288, Whitehead No. 284,585, Schaer No. 287,585, Falls No. 436,577, Falls, No. 500,120, Nichols No. 841,809, Nichols No. 1,113,472, Stiggins No. 1,163,115, and Denne No. 1,651,588. Models of the McMahan, Hardel and Kinley prior art patented devices, as well as of the Chaney-Barnes patent in suit and appellants' devices held to infringe, have been furnished for our study and inspection, and their relative structure and mode of operation were ably demonstrated for our benefit by counsel upon the oral argument.

[7] See and compare Jeoffroy Mfg., Inc. v. Graham, 5th Cir., No. 15,117, decided February 11, 1955; and Stewart-Warner Corp. v. Lone Star Gas Co., 5th Cir., 195 F 2d 645, 648.

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close no invention over the prior art and are invalid for anticipation by it; conversely, if they be properly construed as impliedly including the centering device, so as to attain validity over the prior art, they are then invalid for non-compliance with the statutory mandate that a patentee must "distinctly claim" his invention; that the claims are valid, if at all, only when narrowly construed, and are not infringed by appellants because their devices follow the teachings of the prior art, particularly the McMahan patent, and do not use the combination of the patent in suit because they do not employ a centering device or measure the depth of the deepest pit, and also because the "feelers springs" of their device do not use the relative spring strength called for by the Chaney-Barnes patent in suit.[8]

Appellee insists that each of the district court's findings of fact and conclusions of law on the basic issues of validity and infringement, as well as the special defenses of prior public use and late claiming, should be sustained as amply supported by the record; that, in any event, the trial court's decision is not clearly erroneous and appellants, by here asserting practically the same defenses as were urged in the trial court, are merely attempting to broaden the ordinary scope of appellate review and retry identical factual issues heretofore resolved against them upon substantial evidence. Specifically, appellee insists that appellants' reliance in its late claim-

[8] This final contention of appellants involves the proper interpretation of the second heretofore quoted and italicized phrase in Claim 1 of the patent, supra, viz: "means for constantly and independently urging the * feeler outwardly of said housing * * with a force greater than" the stylus return spring, which element appellants claim is lacking in their devices because the "feeler springs" are supposedly too weak to measure the depth of the deepest pit in the manner of the Chaney-Barnes patent in suit.

ing defense upon the Muncie Gear case, *supra*, is misplaced, since the patent there involved was held invalid because the untimely filed claims disclosed "new matter" not contained in the original application, whereas the Chaney-Barnes patent in suit continuously claimed substantially the same invention, and further because the decision was not primarily based upon intervening rights or any other form of equitable estoppel here urged by appellants; that the testimony fully supports the district court's findings of validity over the prior art, since the prior art calipers, such as McMahan, Hardel and DeLeeuw, either measured only average diameter rather than the deepest pit or, under the rule of *Potts* v. *Creager*, 155 U. S. 597, 606-608, may not fairly be viewed as anticipation because taken from non-analogous arts; that appellants' "centering device" and "weak feeler spring" defenses, heretofore summarized, represent merely an ingenious partisan attempt to read implied limitations into express language of otherwise clear and unambiguous claims which do not actually exist, and appellants may not, by resorting to such strained and abortive claim construction, thereby escape the consequences of their willful infringement through manufacture and use of the accused devices, which reveal in combination substantially the same mechanical elements, functioning in substantially the same way, to accomplish substantially the same result.

Conceding the prior use statute's adoption of the general equitable principle, as set forth in the Muncie Gear case, *supra*, and elsewhere (Cf. *Webster Co.* v. *Splitdorf Co.* 264 U.S. 463, 469), that a delay in claiming for more

than the statutory period after adverse public use would ordinarily preclude the existence of a monopoly thus untimely asserted, we think the district court correctly held that, assuming a reasonable application of the doctrine of equivalents, there has been no material departure here between the monopoly asserted before the Patent Office and that presently claimed, nor any such unreasonable delay in claiming subsequent to the Kinley alleged public use, as would fairly justify invalidation of the patent claims in suit. Cf. *Jeoffroy Mfg., Inc.* v. *Graham,* 5th Cir., No. 15,117, February 11, 1955; see *Matthews* v. *Koolvent Metal Awning Co.,* 5th Cir., 158 F. 2d. 37, 40. We further agree that, as revealing the first practical patented device for measuring the depth of the deepest pits in well tubing, rather than merely the average depth of all corrosion pits encountered, the claims of the Chaney-Barnes patent are valid over the prior art. *Robertson Rock Bit Co.* v. *Hughes Tool Co.,* 5th Cir., 176 F. 2d. 783, 789, 790. We think that neither the express language of the claims, nor the doctrine of equivalents, may be so narrowly circumscribed as to impose limitations and restrictions on the patent, such as are inherent in acceptance of appellants' "centering device" and "weak feeler spring" defenses, that appellee, by omitting any express reference thereto in claiming its monopoly, undoubtedly sought to avoid. Cf. *Southern States Equip. Corp.* v. *USCO Power Equip. Corp.,* 5th Cir., 209 F. 2d. 111, 121; *Hughes* v. *Magnolia Petroleum Co.,* 5th Cir., 88 F. 2d. 817, 818. Moreover, in view of the structural and functional differences found to exist between the Otis caliper, held to infringe the McMahan prior art patent in the unreported Dallas suit, and the

type caliper revealed by the present Chaney-Barnes patent here in dispute, we think the prior adjudication, if it has any bearing at all, is only remotely persuasive, and logically compels no result favorable to appellants here.

No useful purpose would be served by unduly lengthening this opinion with any further discussion of the divergencies in purpose, structure and modus operandi of the various prior art patents or the many authorities cited. As heretofore stated, on the basic issues of validity and infringement, as well as the special defenses of late claiming and intervening rights based on the alleged Kinley prior use, we find ourselves generally in agreement with the findings and conclusions adopted by the district court,[9] many of which have been heretofore summarized. In spite of appellants' contrary insistence, we agree with appellee's assertion that essentially only issues of fact were involved in its rejection of most of the asserted defenses, and that the ultimate determination of the controlling facts here was peculiarly for the district court, after hearing all of the disputed testimony, including that of the expert witnesses during more than nine days of trial. Furthermore, a review of appellants' contentions in the light of the testimony, the prior art, and the physical exhibits, has convinced us that they either assume facts not found, or conflict with contrary findings based on disputed testimony which may not fairly be set aside as "clearly erroneous." See *Graver Mfg. Co.* v. *Linde Co.*, 336 U.S. 271, 274-275; *Hazeltine*

[9] For a recent case upholding the district court's authority to adopt sua sponte, after independent consideration, that version of proposed findings of fact and conclusions of law submitted by both parties which fairly reflects the record and best accords with its conception of justice in the particular case, see Vincent, et al., v. Suni-Citrus Products Co., et al., 5th Cir., 215 F. 2d. 305. 310-311.

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Research v. *Admiral Corp.*, 7th Cir., 183 F. 2d. 953, 955; *Hunt* v. *Armour & Co.*, 7th Cir., 185 F. 2d. 722, 728; Rule 52(a), F.R.C.P.; *Jeoffroy Mfg., Inc.* v. *Graham*, 5th Cir., 206 F. 2d. 772, 778-779; *Southern States Equip. Corp.* v.*USCO Power Equip. Corp., supra*, at p. 120. For example, as a purely abstract proposition of mechanics there is undoubtedly a germ of truth in appellants' assertion and the testimony to the effect that an "off center shift" results from using the Chaney-Barnes patented structure without the centering device which prevents perfect accuracy in attaining the avowedly novel patent purpose of measuring the depth of the deepest pit encountered. But other witnesses for appellee, such as Fredd and Kelly, testified that this slight amount of theoretical off-center shift was so inconsequential as to be practically de minimis under ordinary operating conditions.[10]

[10] The witness Fredd testified:

"Q. Now, what was the result of that calculation as to offset or center shift that would be obtained under those assumptions?

"A. Under these assumptions with five feelers against a smooth cylindrical bore, the sixth feeler in a pit of one-tenth-inch in depth, the off center shift, the maximum value of off center shift that could be expected from the unbalance of forces would be thirty-three thousandths of an inch.

"Q. Did you make a similar calculation under exactly the same assumptions except for increasing the number of feelers from six to twelve?

"A. Yes sir; we did.

"Q. And what was the result of that twelve-feeler calculation as to center offset?

"A. In connection with the twelve-feeler problem we assumed that eleven feelers would be against this smooth and uniform here, the twelfth feeler would be in a pit of the depth of one-tenth of an inch, the maximum possible calculated off center shift that could occur due to the imbalance of forces created by the one feeler moving into the pit had a value of seventeen thousandths of an inch.

"Q. Did you make a similar calculation for eighteen feelers with seventeen feelers retained by the tube wall and the eighteenth feeler moving in a pit one-tenth of an inch deep?

"A. Yes; we did.

"Q. What was the result of that calculation?

"A. This calculation showed that the maximum possible off center shift under these conditions was eleven thousandths of an inch.

"Q. Now, taking exactly the same conditions, the seventeen feelers retained by the smooth wall and the eighteenth feeler in a pit, but this time the pit is only five thousandths of an inch deep. Did you make this calculation, and if so, what was the result?

In fact, their testimony and the district court's findings as to the ability of the spring feelers to maintain the caliper in a substantially centered position in the absence of the centering device are supported by other testimony that the importance of a centering device is diminished as the number of feelers used increases, and also by the similarity between the field records produced by the Chaney-Barnes type caliper and those used by appellants which were held to infringe. Finally, we think appellants' contention, purportedly based on the second italicized portion of the claim, that it does not infringe because of its use of weaker feeler springs than those called for by the patent in suit, is effectively refuted by

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"A. Yes; we did. The answer was the off center shift could not exceed four hundred fifty millionths of an inch.

"Q. And that figure of four hundred fifty millionths of an inch is less than one-half of one thousandths of an inch; is that correct?

"A. That is correct.

"Q. Could you give us a simple illustration of one one-thousandths of an inch?

"A. An illustration would be the cellophane that is used to wrap cigarette packages. This value is less than one-half of that thickness."

Kelly further testified:

"Q. * * * When the Otis Caliper goes through bent or crooked tubing and is deflected by the wall of the tubing, what is the maximum possible off center movement of the caliper?

"A. * * * The difference in the diameter of the outside of the housing of the Otis caliper and the internal diameter of the tubing is three-eighths of an inch. That means it will be possible for the Otis caliper to move off center not more than three-sixteenths of an inch.

"Q. And that would be the most extreme off center movement that could be obtained under the most extreme conditions?

"A. It would not be possible to put the caliper in two-inch tubing and get it off center more than three-sixteenths.

"Q. What about the Tuboscope caliper?

"A. I believe the Tuboscope caliper outside diameter is one and three-quarters inches, which means it will be possible to deflect the Tuboscope caliper off center not more than one-eighth of an inch.

"Q. What about the effect of the drive wheel and centering wheel — I mean the drive wheel and back-up wheel in these calipers? What practical effect in the field do they have for centering the instrument?

"A. For all practical purposes that back-up post and drive wheel in the Tuboscope instrument represents a centering device which holds that caliper centered in the tubing."

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testimony supporting the trial court's finding that this language may not fairly be construed as a limitation of the claims which avoids infringement, but is largely a variable factor of optional engineering design.

It follows that the district court properly held the Chaney-Barnes patent in suit valid and infringed, and the judgment is accordingly.

AFFIRMED.

JUDGMENT

Extract from the Minutes of March 11, 1955.

TUBULAR SERVICE AND ENGINEERING COMPANY, TUBOSCOPE COMPANY, MYRON M. KINLEY AND JOHN CARY KINLEY,

No. 15177.

v.

SUN OIL COMPANY.

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Texas, and was argued by counsel;

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, affirmed;

It is further ordered and adjudged that the appellants, Tubular Service and Engineering Company, Tuboscope Company, Myron M. Kinley and John Cary Kinley, and the surety on the supersedeas bond herein, National Automobile and Casualty Insurance Co., be condemned, in solido, to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

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FILED
MAY 18 1955
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 773

TUBULAR SERVICE AND ENGINEERING COMPANY, TUBOSCOPE COMPANY, MYRON M. KINLEY, AND JOHN CARY KINLEY, *Petitioners*

v.

SUN OIL COMPANY, *Respondent*

BRIEF FOR RESPONDENT

In Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

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BRIEF FOR RESPONDENT
In Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

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The Respondent submits that the Petition for a Writ of Certiorari in the above cause should be denied for the following reasons:

1. The Petition viewed as a whole does not provide any reasons of the character contemplated by Rule 38(5) for the issuance of the writ.

2. The questions presented by the Petition "involve the doctrine of file wrapper estoppel and the doctrine of equivalents. These doctrines are involved in practically all patent litigation." (Petition, p. 9.) These doctrines have been well settled by this Court. These questions have no uniqueness such

as to justify the attention of this Court in this particular private controversy.

3. The two legal questions presented appear from the Petition itself to include and require factual assumptions of the Petitioners that are diametrically opposed to the Findings of Fact made by the District Court and accepted and approved by the Court of Appeals for the Fifth Circuit (see Findings Nos. 36, 37, 38, 47, 48, 49; R. p. 1098-9, 1101). For this Court to consider these questions would require a third review of the evidence.

4. A file wrapper estoppel entails a change of position on the part of the patentee. In the case at bar, there was no such change of position because Chaney and Barnes were consistently claiming the same invention (Finding No. 48; R. p. 1101).

5. The doctrine of equivalents was not resorted to in this case either by the Plaintiff or the Courts below for the purpose of establishing infringement of the claims in suit. Instead, it was used merely to show that certain claims presented during the prosecution of the Chaney-Barnes application, both prior and subsequent to Petitioners' alleged adverse public uses, were directed to the same invention as the claims in suit and likewise would have covered the Petitioners' tubing calipers. The Courts below found that said alleged public uses "were not public uses" (Finding No. 47; R. p. 1101).

6. The Record contains no evidence whatever of the concentration of use of the invention in the Fifth Circuit that is alleged in the Petition; and the exact contrary is the fact, as is shown by the deposition of the Defendant-Petitioner M. M. Kinley taken

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herein on March 18, 1952, pages 57-8. That deposition is not included in the Record, and the foregoing portion is therefore given in a footnote.

Respectfully submitted,

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"Q. Do you and J. C. Kinley have any other companies than the Tubular Service and Engineering Company under licenses covering the McMahan Patent?

A. No, I don't think we do.

Q. Is the Technical Service Company of California licensed by you?

A. They handle our tool.

Q. They do not, then, operate under a license?

A. I don't think they have a license, a contract.

Q. Under what arrangements do they operate the tool?

A. They operate it on a fifty-fifty basis.

Q. Fifty-fifty of what?

A. Of the survey charge.

Q. That is their gross charge, then?

A. What?

Q. Their gross charge, then?

A. The charge to the customer for the survey."

Certificate of Service

A copy of this brief has been mailed to each of the attorneys for Petitioners, Earl Babcock, Esq. and Thomas O. Arnold, Esq., at their addresses of record, this 17th day of May, 1955.

Attorney for Respondent